

REMARKS

With this amendment, claims 131-137 and 139-147 are in this application. Claims 1-130, and 138 have been cancelled without prejudice. Applicant retains the right to present the cancelled claims in a divisional application. The present set of claims contains 16 total claims and 4 independent claims. A fee for one additional independent claim is enclosed to the present amendment.

35 USC 112 Rejections

In the Action of September 3, 2003, the Examiner rejects claims 138 and 141-144 under 35 USC § 112, second paragraph. The Applicant has cancelled claim 138 and amended claims 141-144. The Applicant submits that the claims as amended comply with the requirements of 35 USC § 112, second paragraph.

35 USC 102 rejections

In the Action, the Examiner rejects claims 131-134, 136, 137 and 139-142 under 35 USC 102(b) as being anticipated by U.S. Pat. No. 901,333 to Fitzgerald. Applicant respectfully disagrees. Independent claims 131 and 139 recite "*a decorative insert . . . positioned below [a] top.*" Figure 14 of Fitzgerald shows an insert 22 which is flush with a top of a box 2. See Fitzgerald, column 3, line 40. The Applicant submits that an insert which is flush with a top is not below a top.

Therefore, Applicant submits that Fitzgerald does not anticipate claim 131 or claim 139. Claims 132-134, 136, and 137 depend, directly or indirectly, on claim 131. Similarly, claims 140-142 depend, directly or indirectly, on claim 139. Therefore, they are deemed not to be anticipated by Fitzgerald at least by virtue of their dependency on claims 131 or 139.

The Examiner rejects claims 131-137 and 139-142 under 35 USC 102(b) as being anticipated by U.S. Pat. No. 5,289,700 to Cheng. Applicant respectfully disagrees.

The Examiner takes the position that "Cheng shows a base member 11, and a decorative insert 16." However, the element 16 in Cheng is a stop member (Cheng, column 2, lines 44, 59, and 67). A stop member is not a decorative insert. Additionally, an ornamentation or gem stone is already present in Cheng and is referenced by numeral 19 (Cheng, column 2, lines 64 and 68). Further, neither the stop member 16 nor the ornamentation 19 are "*configured and sized in relation to [a] base member top opening to be inserted, through said top opening, into [a] hollow interior [...] and positioned below said top*" as claimed in claims 131 and 139. See, for example, Figure 2 in Cheng. Therefore, independent claims 131 and 139 are deemed not to be anticipated by Cheng, together with the remaining claims 132-137 and 140-142 which depend, directly or indirectly, on claims 131 and 139, respectively.

35 USC 103 Rejections

The Examiner rejects claims 138, 143 and 144 under 35 USC 103(a) as being unpatentable over Fitzgerald. The Applicant respectfully disagrees. Claim 138 has been cancelled thus rendering moot the rejection of the Examiner. With reference to claims 143 and 144, even assuming, arguendo, that they only involve duplication of some of the components shown in Fitzgerald, both claims depend, directly or indirectly on claim 139, which recites a decorative insert "*positioned below [the] top.*" Fitzgerald teaches against positioning a decorative insert below the top. In Fitzgerald, the signet plate must be "of a shape to fit exactly within the flange or bezel 3 of the box or head 2" (emphasis added). See Fitzgerald, column 3, lines 17-19. Therefore, the person skilled in the art would not be motivated to change the disposition of the signet plate within the bezel.

Double Patenting

In the Advisory Action, pending claims 131-133, 136 and 138-141 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over some of the claims of copending application No. 09/953,626, now

matured into U.S. Pat. No. 6,629,434.

U.S. Pat. No. 6,629,434 and the present application are commonly owned. Enclosed herewith is a terminal disclaimer, and the associated fee, disclaiming the terminal part of the statutory term of any patent granted on the present application, which would extend beyond the expiration date of U.S. Pat. No. 6,629,434. Therefore, the Applicant submits that, with the submission of the terminal disclaimer, under 37 C.F.R. 1.130(b) the grounds for rejecting the claims based on double patenting have been overcome.

New Claims

Applicant has added new claims 145-147. New claim 145 is similar to cancelled claim 138. Support for new claims 146-147 can be found, for example, in Figures 2, 3, and 16-18, and related portions of the specification. Applicant submits that claims 145-147 are patentable over Fitzgerald and Cheng.

* * *

Applicant submits that all claims of the application are in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

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Examiner: Chop, Andrea Marie
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The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patent P.O. Box 1450 Alexandria, VA 22313-1450 on

November 25, 2003
(Date of Deposit)

Ross A. Schmitt
(Name of Person Depositing)

Ross A. Schmitt
Signature
11-25-03
Date

Respectfully submitted,

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Enclosures:

- Petition for excess claims fee
- Excess claim Check for excess claims in the sum of \$ 43
- Terminal disclaimer
- Check for terminal disclaimer in the sum of \$ 55
- Postcard